

REMARKS/ARGUMENTS

Applicants have carefully reviewed the Final Office Action mailed on January 22, 2009. Applicants respectfully traverse all objections, rejections, and assertions made by the Examiner. Claims 1, 3, 4, 6-15, 17-54, and 61-67 are pending. Claims 23-54, 61, and 62 have been previously withdrawn. Claims 1, 3, 4, 6-15, 17-22, and 63-67 stand rejected. Favorable consideration of the following remarks is respectfully requested.

Claim Rejections under 35 U.S.C § 103

On page 2 of the Office Action, claims 1, 3-4, 12-15, 22, and 63-67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian (U.S. Patent No. 5,178,159) in view of Frisbie et al. (U.S. Patent No. 5,517,989). Applicants respectfully traverse this rejection.

Independent claim 1 recites:

1. (Previously Presented) A guidewire, comprising:
 - a core member having a proximal end and a distal end, wherein the core member is generally solid in cross-section;
 - a metallic tubular member having a proximal end and a distal end and a lumen therebetween, the tubular member connected to the distal end of the core member, the distal end of the core member disposed in the lumen of the tubular member and the distal end of the tubular member extending distally beyond the distal end of the core member; and
 - a coil member connected to and disposed about the tubular member;
 - wherein the coil member includes a distal end and a proximal end, and wherein the distal end of the coil member extends distally beyond the distal end of the tubular member,
 - wherein the coil member has an outer diameter and wherein the tubular member has a maximum outer diameter that is less than the outer diameter of the coil member.

Christian does not appear to teach or suggest the tubular member has a maximum outer diameter that is less than the outer diameter of the coil member. The Examiner does not appear to address this limitation in the Office Action. MPEP 2143.03 states, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). As can be seen in Figure 12 of Christian, which has been reproduced below, Christian appears to teach the outer diameter of the coil spring 210 is the same as or smaller than the outer diameter of the housing 206.

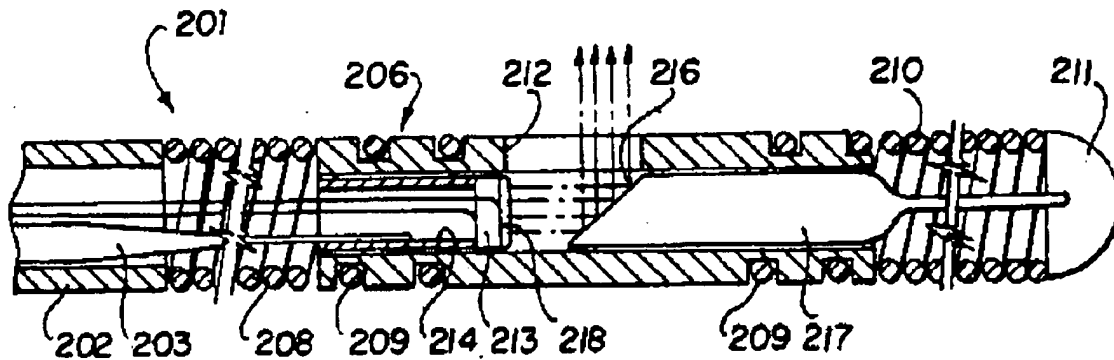


FIG.—12

Frisbie et al. do not appear to teach that which Christian lacks. Frisbie et al. teach at column 4, lines 36-39, "The body 12 is made of an electrically conductive material which comprises spring coils 15 towards the distal end 16 of the body 12, and a smooth sleeve section 17 towards the proximal end 18." Frisbie et al. do not appear to teach or suggest the tubular member has a maximum outer diameter that is less than the outer diameter of the coil member. Thus, even if one were to combine the teachings of Christian and Frisbie et al., one would not arrive at the invention as claimed. Furthermore, there appears to be no motivation, suggestion or other reason for one of ordinary skill in the art to modify Christian or Frisbie et al. to arrive at the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested. Applicants submit that claims 3, 4, 12, 13, 63, and 64 are also in condition for allowance as they depend from claim 1 and add significant limitations to further distinguish them from the prior art.

Turning now to independent claim 14, which recites:

14. (Previously Presented) A guidewire comprising:
 - a core member including a proximal portion having a proximal end and a distal portion having a distal end, wherein the core member is generally solid in cross-section; and
 - a distal assembly including a metallic tubular member having an inner surface adapted for connection to the distal portion of the core member, and an outer surface, and a coil member connected to the tubular member;wherein the distal assembly is connected to the distal portion of the core member such that a portion of the distal assembly extends distally beyond the distal end of the core member;

wherein the coil member includes a distal end and a proximal end, and wherein the distal end of the coil member extends distally beyond a distal end of the tubular member,

wherein the coil member has an outer diameter and wherein the tubular member has a maximum outer diameter that is less than the outer diameter of the coil member.

As discussed above, neither Christian nor Frisbie et al. either alone or in combination appear to teach the tubular member has a maximum outer diameter that is less than the outer diameter of the coil member. Thus, even if one were to combine the teachings of Christian and Frisbie et al., one would not arrive at the invention as claimed. Furthermore, there appears to be no motivation, suggestion or other reason for one of ordinary skill in the art to modify Christian or Frisbie et al. to arrive at the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested. Applicants submit that claims 15, 22, 65, and 66 are also in condition for allowance as they depend from claim 14 and add significant limitations to further distinguish them from the prior art.

Turning now to independent claim 67, which recites:

67. (Previously Presented) A guidewire, comprising:

a metallic core member having a proximal end and a distal end, wherein the core member is generally solid in cross-section;

a metallic tubular member having a proximal end and a distal end disposed about and attached to the distal end of the core member; and

a metallic coil member disposed about and attached to the distal end of the tubular member,

wherein the tubular member has a uniform inner diameter and a uniform outer diameter and wherein the distal end of the core member where the tubular member is attached has an outer diameter that is less than the inner diameter of the tubular member and wherein the coil member has an inner diameter that is greater than the outer diameter of the tubular member, and

wherein the tubular member extends distally beyond the distal end of the core member and the coil member extends distally beyond the distal end of the tubular member.

Christian does not appear to teach or suggest the tubular member has a uniform inner diameter and a uniform outer diameter. The Examiner does not appear to address this limitation in the Office Action. Referring back to Figure 12 of Christian, presented above, Christian appears to teach the coils 208/210 are disposed within grooves 209 in the housing 206. The grooves 209,

appear to create areas within the housing 206 that have a smaller outer diameter than the rest of the housing 206. Thus Christian cannot be considered as teaching or suggesting a tubular member having a uniform outer diameter.

Further Christian does not appear to teach or suggest the coil member has an inner diameter that is greater than the outer diameter of the tubular member. As discussed above, Christian appears to teach the coil 210 is disposed within a groove 209 in the housing 206. Also, Christian appears to teach the coil 210 has an outer diameter that appears to be the same as the outer diameter of the housing 206. Thus Christian cannot be considered as teaching or suggesting the coil member has an inner diameter that is greater than the outer diameter of the tubular member.

Frisbie et al. do not appear to teach that which Christian lacks. Christian does not appear to teach or suggest a coil member has an inner diameter that is greater than the outer diameter of a tubular member as presently claimed. Thus, even if one were to combine the teachings Christian and Frisbie et al., one would not arrive at the invention as claimed. Furthermore, there appears to be no motivation, suggestion or other reason for one of ordinary skill in the art to modify Christian or Frisbie et al. to arrive at the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested.

On page 5 of the Office Action, claims 6-7 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian (U.S. Patent No. 5,178,159) in view of Frisbie et al. (U.S. Patent No. 5,517,989) and in further view of Richardson et al. (U.S. Patent No. 6,673,025).

On page 5 of the Office Action, claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian (U.S. Patent No. 5,178,159) in view of Frisbie et al. (U.S. Patent No. 5,517,989) and in further view of Palmer et al. (U.S. Patent No. 6,544,231).

On page 6 of the Office Action, claims 9-10 and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian (U.S. Patent No. 5,178,159) in view of Frisbie et al. (U.S. Patent No. 5,517,989) and in further view of Cook et al. (U.S. Patent No. 5,213,111).

On page 6 of the Office Action, claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian (U.S. Patent No. 5,178,159) in view of Frisbie et al. (U.S.

Patent No. 5,517,989) in view of Cook et al. (U.S. Patent No. 5,213,111) and further in view of Palmer et al. (U.S. Patent No. 6,544,231).

On page 7 of the Office Action, claims 18 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian (U.S. Patent No. 5,178,159) in view of Frisbie et al. (U.S. Patent No. 5,517,989) and further in view of Palmer et al. (U.S. Patent No. 6,544,231).

On page 7 of the Office Action, claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Christian (U.S. Patent No. 5,178,159) in view of Frisbie et al. (U.S. Patent No. 5,517,989) and further in view of Buchbinder et al. (U.S. Patent No. 4,815,478). Applicants respectfully traverse this rejection.

For at least the reasons discussed above independent claims 1 and 14, from which the above claims depend, are believed patentable over the combination of Bonello et al. and Gambale. None of Richardson et al., Cook et al., Palmer et al., and Buchbinder et al., appears to teach that which Bonello et al. and Gambale lack. Thus, the cited references neither alone nor in combination appear to teach or suggest the claimed invention. Reconsideration and withdrawal of the rejections are respectfully requested.


Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their attorney,

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